

## **REMARKS**

In response to the above-identified Office Action (“Action”), Applicants traverse the Examiner’s rejection to the claims and seek reconsideration thereof. Claims 1-6 are pending in the present application. In this response, claims 1 and 5 are amended, claim 2 is cancelled and no claims are added.

### **I. Claim Amendments**

Applicants respectfully submit herewith amendments to claims 1 and 5. Claim 2 is cancelled. Claim 1 is amended to incorporate the limitations of now cancelled claim 2 and is further amended to recite that the number of repeating units in the oligomer is 2 to 50. Support for the amendments to claim 1 may be found, for example, on page 4, lines 1-2 and original claim 2 of the Application. Claim 5 is amended to clarify that the cyclic amide monomer has a cyclic structure. Support for the amendments to claim 5 may be found, for example, on page 5, line 20 of the Application.

Applicants respectfully submit the amendments do not add new matter and are supported by the specification. Accordingly, Applicants respectfully request consideration and entry of the amendments to claims 1 and 5.

### **II. Claim Rejections – 35 U.S.C. §112**

In the outstanding Office Action, claims 1, 2 and 5 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is cancelled therefore the rejection of claim 2 on this basis is moot.

Applicants respectfully submit herewith amendments to claims 1 and 5 in which claim 1 is amended to replace the term “the” with “a” before the term “step” to provide proper antecedent basis for this element and the range of “1 to 50” is amended to recite “2 to 50.” Claim 5 is amended to delete the element of caprolactam. Applicants believe the amendments are

responsive to the rejections raised by the Examiner and place the claims in compliance with 35 U.S.C. §112. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1 and 5 under 35 U.S.C. §112.

### **III. Claim Rejections – 35 U.S.C. §103**

**A.** In the outstanding Action, claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0049285 issued to Abe (“Abe”) in combination with U.S. Patent No. 6,436,548 issued to Phelps (“Phelps”). Applicants respectfully traverse the rejections.

To establish a *prima facie* case of obviousness, the Examiner must set forth “some articulated reasoning with some rational underpinning to support the conclusion of obviousness.” See KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (2007). In combining prior art elements to render the claimed combination of elements obvious, the Examiner must show that the results would have been predictable to one of ordinary skill in the art. See Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103, Section III(D), issued by the U.S. Patent and Trademark Office on October 10, 2007.

Claim 2 is cancelled therefore the rejection of claim 2 on this basis is moot.

In regard to independent claim 1, Applicants respectfully submit Abe and Phelps fail to disclose or render predictable at least the element of a method for preparing a polyester copolymer containing amide links including the element of polymerizing a macrocyclic polyester oligomer and cyclic amide monomer as claimed. Applicants respectfully submit that the polyester copolymer containing amide links formed according the claimed method has a superior compatibility, a reduced phase separation and a transparency. See Application, page 2, lines 12-21.

In the Action, the Examiner alleges Abe discloses all the elements of claim 1 except for a macrocyclic polyester oligomer as claimed. The Examiner instead relies upon cols. 3-4 of Phelps to disclose this element. See Action, page 4.

Abe discloses molded articles having an antistatic property and a desired surface resistivity. See Abe, paragraph [0008]. Abe's molded articles are prepared by a copolymerization of (a) a cyclic amide and (b1) cyclic ester or (b2) linear ester. The (a) cyclic amide includes  $\omega$ -lactam of the carbon number of from 4 to 12. See Abe, paragraph [0067]. However, the (b1) cyclic ester of Abe includes  $\omega$ -lactone of the carbon number of from 3 to 12 (for example,  $\beta$ -propiolactone,  $\beta$ -butyrolactone,  $\beta$ -valerolactone, and so on, (See paragraph [0068]), and the (b2) linear ester includes polyesterpolyol, polyesteretherpolyol or polycarbonatepolyol (See paragraph [0069]).

Phelps discloses a method of modifying a physical property (for example, a melting temperature) of a composition comprising macrocyclic polyester oligomers. See Phelps, claims 1 and 2. In Phelps, it is neither disclosed nor contemplated that the macrocyclic polyester oligomers may be used for a copolymerization with a cyclic amide or have a superior compatibility with a cyclic amide. In the absence of such a disclosure, it would not have been obvious for one of ordinary skill in the art to use the macrocyclic polyester oligomers of Phelps instead of the (b1) cyclic ester of Abe to arrive at the claimed polyester copolymer containing amide links formed by polymerizing a macrocyclic polyester oligomer and a cyclic amide monomer. Thus, for at least the foregoing reasons, the Examiner has not established that claim 1 is not *prima facie* obvious over Abe and Phelps. Applicants respectfully request reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. §103 over Abe and Phelps.

In regard to claims 3-6, claims 3-6 depend from claim 1 and incorporate the limitations thereof. Thus, for at least the reasons that claim 1 is not *prima facie* obvious over Abe and Phelps, claims 3-6 are further not obvious over the cited prior art references. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 3-6 under 35 U.S.C. §103 over Abe and Phelps.


### CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1 and 3-6, are now in condition for allowance and such action is earnestly solicited at the earliest possible date. If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. Questions regarding this matter should be directed to the undersigned at (310) 207-3800.

Respectfully submitted,

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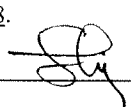
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#### **CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being submitted electronically via EFS Web to the United States Patent and Trademark Office on January 29, 2008.

  
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